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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,916	05/24/2001	John Rodriguez	LS/0026.00	5324

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EXAMINER
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GRAYSAY, TAMARA L

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/865,916

Applicant(s)

RODRIGUEZ, JOHN

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2 pages</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

2. The drawings are objected to
- a. as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:  $\text{OI}_3$  (Fig.4C);
  - b. because Fig.5C does not include any reference character(s), e.g., 550; and,
  - c. as noted on the attached Notice of Draftsperson's Patent Drawing Review, form PTO-948.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified

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and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
4. The disclosure is objected to because of the following informalities:
  - a. Page 13, line 26, reference character 116 should be 216.
  - b. Page 13, line 27, reference characters 102 and 100 should be 202 and 200, respectively.
  - c. Page 13, line 30, reference character 100 should be 200.
  - d. Pages 16 and 17, reference characters P<sub>1</sub>, P<sub>2</sub>, and P<sub>3</sub> must be used consistently.
  - e. Page 19, lines 26-29, contains a grammatical error.
  - f. Page 20, line 10, it is unclear whether the order scheduler engine (described above) is the order engine 520 or the schedule engine 530. Consistent terminology must be used throughout the specification.
  - g. Page 20, lines 25 and 31, reference character 430 should be 530.
  - h. Page 21, lines 8, 14, and 27, reference character 430 should be 530.
  - i. Pages 24-25, fails to comply with 37 CFR 1.96(b)(2)(ii) because a computer program listing having more than 60 lines of code that is submitted as part of the specification

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must be positioned at the end of the description but before the claims. Any amendment must be made by way of submission of a substitute sheet.

j. Pages 27-36, Appendix A, the source code listing fails to comply with 37 CFR 1.96(c) because any computer program listing having over 300 lines (up to 72 characters per line) must, be submitted on a compact disc in compliance with 37 CFR 1.52(e). A compact disc containing such a computer program listing is to be referred to as a “computer program listing appendix.” The “computer program listing appendix” will not be part of the printed patent. The specification must include a reference to the “computer program listing appendix” at the location indicated in 37 CFR 1.77(b)(4).

Appropriate correction is required.

5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code at pages 6 and 7. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.VII.

### ***Claim Objections***

6. Claims 10, 18 and 19 are objected to because of the following informalities:

- a. Claim 10, lines 9 and 11, the second occurrence of “if” should be of.
- b. Claim 10, last line, the “;” (semicolon) has been treated as a . (period).
- c. Claim 18 is not dependent upon a preceding claim, but instead is dependent upon claim 18. For this Office action, claim 18 has been treated as though it is dependent upon claim 17, which provides antecedent basis for language recited in claim 18.

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Appropriate correction is required.

*Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As a preliminary matter, process claims 8, 9, and 17-19 allude to, but do not positively recite, computer-related subject matter and the disclosure as a whole encompasses computer hardware or computer hardware and software that may be utilized to perform the method. Thus, the claims have been evaluated as though they are directed to a computer-related invention.

A computer-related process claim is first evaluated to determine if it falls within the specific safe harbor categories of statutory post-computer or pre-computer activity. In the present application, the process claims do not include post-computer activity (i.e., there is no step during which an independent physical act is performed outside a computer) or pre-computer activity (i.e., there is no step during which manipulation of data representing physical objects or activities occurs).

Without such activity, the process claims are then evaluated to determine whether they are limited to a practical application within the technological arts.

A process claim that has a practical application is one that provides a useful, concrete and tangible result. In the present application, the claims include receiving an order, ranking fulfillers, and assigning fulfillment of the order. Arguably, the assigning step includes a practical

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application, such as assigning an order that is needs to be filled to a most-favorable fulfiller, based on specified criteria.

A process claim that is within the technological arts is one that applies, involves, uses, or advances technology. A process is a mode of treatment of certain materials to produce a given result. It is an act or series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence. MPEP § 2106,IV,B,2. In the present application, the claims are drawn to a process of assigning product orders to multiple fulfillers. Because the acts, as claimed, are capable of being performed by a human and not claimed as being performed on any subject matter to be transformed and reduced to a different state, the claims are not within the technological arts.

Regarding claims 8, 9, and 17-19, the data structure, as set forth, has been given no weight insofar as it plays merely a passive role of data storage and it is not related to any of the method steps recited in the claims. Without relating the structural limitation(s) of the data structure, which is nonstatutory *per se*, to the method steps or acts being performed, there is insufficient basis for such a structural limitation to render the process claims statutory.

In conclusion, claims 1-20 are directed to nonstatutory subject matter.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The preamble of claim 1 recites a method for assignment to “multiple” fulfillers; however, the body of claim 1 recites fulfillment from “one” or more fulfillers ... and assigning fulfillment to “the most-favorable fulfiller,” i.e., a single fulfiller, if possible. The body of the claim, which includes assignment to a single fulfiller, is not commensurate with the preamble recitation of multiple fulfillers. As a result the scope of the claim is not clearly set forth.
- b. Claim 1, line 5, “said set of fulfillers” lacks clear antecedent basis in the claim. The limitation has been treated as said multiple fulfillers, which is recited in antecedent.
- c. Claim 5, “said multiple” fulfillers is not clear insofar as preceding claim 1 recites “multiple fulfillers” in the preamble, both “most-favorable fulfiller” and “most-favorable fulfillers” in the body of claim 1, and “number of fulfillers” in claim 4. The use of “said multiple” fulfillers in claim 5 is not clear what limitation is being further limited. The claim has been treated as minimizing the cumulative shipping distances of the minimized number of fulfillers.
- d. Claims 8 and 9 recite “two-dimensional data structure” is employed to indicate which fulfillers can fulfill which “types of products” that may be ordered. The features recited are not related to the previously recited method steps of receiving, ranking, and assigning. Moreover, “products” does not have clear antecedent basis and should be related to the previously recited product order, order, or individual order items.



e. The preamble of claim 10 recites a method for improving fairness when assigning to “multiple” fulfillers; however, the body of claim 10 recites fulfillment from “one” or more fulfillers ... and assigning fulfillment to “the most-favorable fulfiller,” i.e., a single fulfiller, if possible. The body of the claim, which includes assigning to a single fulfiller, is not commensurate with the preamble recitation of multiple fulfillers. As a result the scope of the claim is not clearly set forth.

f. Claim 14, “said multiple” fulfillers is not clear insofar as preceding claim 10 recites “multiple fulfillers” in the preamble, both “most-favorable fulfiller” and “most-favorable fulfillers” in the body of claim 10, and “number of fulfillers” in claim 13. The use of “said multiple” fulfillers in claim 14 is not clear what limitation is being further limited. The claim has been treated as minimizing the cumulative shipping distances of the minimized number of fulfillers.

g. Claims 17 and 18 recite “two-dimensional data structure” is employed to indicate which fulfillers can fulfill which “types of products” that may be ordered. The features recited are not related to the previously recited method steps of receiving, determining, ranking, and assigning. Moreover, “products” does not have clear antecedent basis and should be related to the previously recited product order, order, or individual order items.

h. Claim 19 recites “three-dimensional data structure” into a bit vector indicating one or more order items that may be fulfilled by the fulfiller shipping that “corresponding product type.” The features recited are not related to the previously recited method steps of receiving, determining, ranking, and assigning. Moreover, “product type” has clear antecedent basis in claim 17, however, the terminology should be related to the

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previously recited product order, order, or individual order items, as noted with regard to claim 17 above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 7-10, and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bezos (cited by applicant, US-6029141).

Regarding claim 1, Bezos discloses a method for providing assignment of product orders to multiple fulfillers including receiving an order that requires more than one fulfiller (paragraph spanning C.2-3, multiple different sites); ranking the fulfillers based on specified criteria (C.3, L.8-32, an associate recommends selected items); and, splitting the order by assigning fulfillment of items to most-favorable fulfillers that can fulfill the order (paragraph spanning C.2-3, customer shopping cart order is split among items ordered from multiple different sites; C.15, L.51-60 items from merchant or from associate referral).

Regarding claim 7, the step of automatically generating a fulfillment request is met by Bezos insofar as the customer places the order at the fulfiller's website via the shopping cart.

Claims 8 and 9 are met due to the indefiniteness noted above.

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Regarding claim 10, the step of determining desirable attributes is inherent in the fact that, in Bezos, the associate is posting the information about the fulfiller on the website, and in some cases recommending an item offered by the fulfiller.

Regarding claim 16, the step of automatically generating a fulfillment request is met by Bezos insofar as the customer places the order at the fulfiller's website via the shopping cart.

Claims 17-19 are met due to the indefiniteness noted above.

Regarding claim 20, Bezos discloses that the fulfiller is a merchant that supplies the items.

10. Claims 1, 6-10, and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Spiegelhoff (US-5402336).

Regarding claim 1, Spiegelhoff discloses a method for providing assignment of product orders to multiple fulfillers (suppliers / warehouses) including receiving an order that requires more than one fulfiller (input request from orderer, e.g., abstract, ref.54); ranking the fulfillers based on specified criteria (primary warehouses and secondary warehouses, e.g., C.4); and, splitting the order by assigning fulfillment of items to most-favorable fulfillers that can fulfill the order (item ordered from lowest-price warehouse, Fig.3, C.7, L.4-23).

Regarding claim 6, Spiegelhoff meets claim 6 insofar as the secondary warehouses are compared to each other "to ensure fairness" in that the lowest-price warehouse is chosen of all secondary warehouses.

Regarding claim 7, Spiegelhoff meets the limitation of automatically generating a fulfillment request when the order is placed with the primary or secondary warehouse (C.13).

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Claims 8 and 9 are met due to the indefiniteness noted above.

Regarding claim 10, the step of determining desirable attributes is inherent in that Spiegelhoff includes primary and secondary warehouses.

Regarding claim 15, Spiegelhoff meets claim 15 insofar as the secondary warehouses are compared to each other "to ensure fairness" in that the lowest-price warehouse is chosen of all secondary warehouses.

Regarding claim 16, Spiegelhoff meets the step of automatically generating a fulfillment request insofar as the customer places the order using the edit order file routine.

Claims 17-19 are met due to the indefiniteness noted above.

Regarding claim 20, Spiegelhoff discloses that the fulfiller is a supplier.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-5 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spiegelhoff (US-5402336).

Spiegelhoff discloses a separate element for adjusting shipping (freight) charges.

However, at column 12, lines 24-27 of the reference read that the subroutine for editing shipping charges can be incorporated into the edit warehouse routine. Spiegelhoff discloses minimizing

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costs; however, it does not specifically address minimization of shipping costs relative to any particular party to the transaction.

The examiner takes Official Notice that minimizing costs is old and well established in the retail business as a way to increase profitability.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Spiegelhoff to include minimizing shipping costs by taking the shipping costs into consideration when assigning fulfillment of an order because the skilled artisan would have recognized that this business practice increases profits.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Southam (US-6594641) teaches payment of commission based on geographic location of retailer.
- Brockwell (US-5063506) teaches minimizing cost when obtaining parts used in manufacturing.

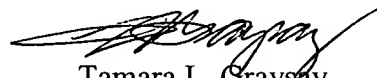
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918.

The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamara L. Graysay  
Examiner  
Art Unit 3623

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